

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No.:3801**
Ron KEY et al. : Examiner: Tam M. Nguyen
Serial No.: 09/931,218 : Group Art Unit: 1764
Filed: August 16, 2001 :

Title: **PROCESS FOR C2 RECOVERY**

TECHNOLOGY CENTER 1700
Commissioner for Patents
P.O. Box 1450
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**PETITION FOR WITHDRAWAL OF FINALITY
OF OFFICE ACTION UNDER 37 C.F.R. §1.181**

SIR:

This is a petition requesting the Commissioner, through the Honorable Group Director, to reverse the Examiner's decision in making the Office Action of June 7, 2007 a Final Office Action.

Statement of Facts

On February 7, 2007, about 5 ½ years after the instant application was filed, the Examiner issued the first Office Action on the merits. In the February 7, 2007 Office Action, claims 6-7 were rejected under 35 USC 103 (a) as being obvious in view of Fogiletta et al. (US 6,712,880). Claims 6-7 were also rejected under 35 USC 112, second paragraph, on grounds of insufficient antecedent basis for certain terms.

On March 29, 2007, applicants filed a Reply to the Office Action of February 7, 2007. In the Reply, applicants amended claims 6-7, and added new claims 8-24. With respect to the prior rejection under 35 USC 103(a), applicants pointed out that, among other things, the instant divisional application claimed benefit of its parent application, Serial No. 09/527,175

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(now US Patent No. 6,278,035). As a result, the instant application had a priority date of March 17, 2000, and that this date was well before the filing date of Fogiletta et al. (US 6,712,880), and any priority date claimed by Fogiletta et al. Thus, the applicants had shown that there was **never** any basis for a rejection of claims 6-7 under 35 USC 103(a) in view of Fogiletta et al. (US '880).

The next Office Action on the merits was issued on June 7, 2007. This Office Action was made Final. The Office Action presented new grounds of rejection as to claims 6-7 and alleged that the new grounds of rejection **were necessitated by applicants' amendments**.

In this Office Action claims 6-7 were rejected as being either **anticipated** under 35 USC 102(b) or obvious under 35 USC 103(a) in view of Wilkinson et al. (US 5,799,507). In the rejection, the Examiner made certain allegations as to what Wilkinson et al. (US '507) disclosed. In an attempt to demonstrate where such disclosures could be allegedly found in Wilkinson et al. (US '507), the rejection simply stated "See Figures 1-3." As for obviousness, the rejection merely made the unsupported and conclusory statement that:

In any event any different [sic] can be shown for the apparatus system as opposed to the apparatus taught by Wilkinson, such differences would have been obvious to one of ordinary skill in the art as routine modification of the apparatus in the absence of a showing a unexpected results.

Additionally, the Office Action rejected new claims 11-24 as being either anticipated under 35 USC 102(b) or obvious under 35 USC 103(a) in view of Buck et al. (US 4,895,584). In this rejection, the Examiner made certain allegations as to what Buck et al. (US '584) disclosed. In an attempt to demonstrate where such disclosures could be allegedly found in Buck et al. (US '584), the rejection simply stated "See Figures 1-4." As for obviousness, the rejection merely made the unsupported and conclusory statement that:

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In any event any different [sic] can be shown for the apparatus system as opposed to the apparatus taught by Buck, such differences would have been obvious to one of ordinary skill in the art as routine modification of the apparatus in the absence of a showing a unexpected results.

On September 7, 2007, applicants filed a Reply under Rule 116. In the Reply, applicants requested withdrawal of the Finality of the prior Office Action of June 7, 2007. Applicants argued that the new ground of rejection as to claims 6-7 had nothing to do with amendments to these claims. The amendments were not made in order to distinguish the claimed invention from the prior art. As indicated in the September 7, 2007 Reply, the amendments to claims 6-7 merely eliminated superfluous language and obviated assertions regarding antecedent basis.

The Examiner issued an Advisory Action on September 19, 2007 in which the Examiner denied entry of amendments presented in the September 7, 2007 Reply under Rule 116. In the Advisory Action the Examiner made the following statements regarding withdrawal of the Final Rejection.

The arguments that the amendment to claims 6 and 7 did not distinguish the claims from the reference cited, so the final rejection should be withdrawal [sic] is not persuasive. In the broadest term, diagram the two claimed processes (claims 6&7 before and after amendment) and one would see that there is slightly different [sic] between the two processes. Even if the two claimed processes are **essentially the same or identical**, a final rejection is still proper because applicant had added claims 8-10, which are **dependent on claims 6 and 7** and the limitations in claims 8-10 contain **new matters/issues**.

Summary of Arguments

The new ground of rejection as to claims 6-7 presented in the Final Office Action of June 7, 2007 was clearly necessitated not by any amendment to these claims, but by the simple fact that the initial prior art rejection was undeniably improper. After 5 ½ years of pendency, the first Office Action on the merits issued by the Examiner rejected claims 6-7 in view of a document that was clearly not prior art. Thus, regardless of whether applicants amended claims 6-7 in the Reply to this first Office Action, the Examiner was obligated in the next Office Action to either make a new ground of rejection as to claims 6-7 or allow these two claims.

Applicants did amend claims 6 and 7 in the Reply of March 29, 2007. But, these amendments for the most part deleted superfluous language and provided antecedent basis for terminology, in order to obviate the Examiner's 35 USC 112 rejection. The Examiner has presented no explanation as to why these amendments necessitated that the rejection in view of Fogiletta et al. (US '880) be withdrawn. However, it is clear from the record that the Examiner was compelled to withdraw the rejection in view of Fogiletta et al. (US '880) **because Fogiletta et al. (US '880) was not prior art.**

The Examiner's response in the Advisory Action to applicants' request for withdrawal does not justify maintaining the Finality. First, the Examiner argues that a diagram of the claimed processes shows a slight difference between the claims before and after the amendments. Unfortunately, the Examiner did not make this alleged diagram of record thus applicants do not know what difference(s) the Examiner is referencing, nor do applicants know what the Examiner considers to be "slight" differences. In any event, the question is not whether there are slight differences in the two versions of the claims, but whether these differences required that a new ground of rejection be made.

It is clear from the record, that a new ground of rejection was necessary because the **first ground of rejection was based on a reference that was not prior art**. Moreover, it is also evident that Examiner failed to establish that this particular new ground of rejection was necessitated by the amendments to claims 6-7.

The Examiner further argues in the Advisory Action that “even if the two claimed processes are essentially the same or identical, a final rejection is still proper because applicant had added claims 8-10, which are dependent on claims 6 and 7 and the limitations in claims 8-10 contain new matters/issues.” This assertion is not relevant to the issue of withdrawing Finality. Applicants are not disputing that the addition of new claims can necessitate a new ground of rejection. But, the presentation of claims 8-10 does not necessitate a new ground of rejection pertaining to claims 6-7.

Applicants note that the initial “prior art” rejection of claims 6-7 was on grounds of obviousness, **whereas the second prior art rejection was on grounds of both obviousness and anticipation**. For the amendments to have necessitated a change from an obviousness rejection to an anticipation rejection, the amendments must have broadened the scope of the claims. But, if that is true, then why was the initial rejection withdrawn? If a prior art reference renders obvious all of the features of a claim, why does it suddenly not render obvious less than all of those features (especially when open-ended language “comprising” is involved). The simple answer is that a new ground of rejection was needed because the first rejection was improper because it relied on a reference that in fact was not prior art.

Furthermore, both new prior art rejections presented in the Final Office Action of June 7, 2007, are also **improper**. With respect to anticipation, the rejections fail to indicate where the asserted anticipatory reference discloses each feature of the rejected claim. See, e.g., *Ex parte Levy*, 17 USPQ2d 1461, 1462 (POBA 1990) [“Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the

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applied reference.”]. Merely referring to the Figures does not indicate where the asserted anticipatory reference discloses each feature of the rejected claims.

As for obviousness, neither rejection sets forth the differences between the claimed invention and the cited prior art. See, e.g., *Graham v. John Deere*, 383 U.S. 1 (1966) and *KSR International Co. V. Teleflex Inc.*, 127 S. Ct. 1727 (2007). Further, the rejections fail to explain why such differences are obvious, but merely make a general conclusory and unsupported allegation.

Conclusion and Requested Relief

In view of the above remarks, it is respectfully submitted that the Examiner’s action in making the Office Action of June 7, 2007 was improper. Applicants respectfully request that the Examiner’s action in making the Office Action of June 7, 2007 Final be reversed.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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